REMARKS

Formal Matters

Claims 1-42 are pending and claims 20-40 are withdrawn from consideration.

Claims 1-8, 40, and 41 were examined and rejected.

Claims 9-19 were examined and objected to.

Claims 1 and 2 have been amended to further specify that the mounted slide is one that includes an array that has been previously exposed to a sample, as indicated in the preamble of the claims. Support for these amendments is found in the claims as originally filed, as well as in the specification at, for example, page 4, lines 1-3.

Claim 41 has been amended to specify the identification code is on a front side of the slide and the array is on a rear side of the slide and that the array and identification are read through the front side of the slide positioned in the array reader. Support for these amendments is found in the specification at, for example, page 6, lines 7-12.

The amendments to the claims were made solely in the interest of expediting prosecution, and are not to be construed as acquiescence to any objection or rejection of any claim and without intent to surrender any subject matter encompassed by the originally filed claims (i.e., the pre-amended claims). The Applicants expressly reserve the right to pursue any subject matter encompassed by the originally filed claims in one or more continuation and/or divisional applications.

Claims 9, 10, 11, 15 and 20-40 are cancelled.

Claims 9-19 are objected to as being dependant upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 9, 10 and 15 are cancelled and are rewritten in independent form, including all of the limitations of the base claim and any intervening claims, as newly added Claims 43, 44 and 45, respectively. Claim 11 has been amended to change the dependency from now cancelled Claim 10 to newly added Claim 44. The cancellation of claims is made without prejudice to renewal, without intent to acquiesce to any rejection, and without intent to surrender any subject matter encompassed by the canceled claims. The Applicant expressly reserves the right to pursue any canceled subject matter in one or more continuation and/or divisional applications.

7

Agilent Ref: 10003413-1
United States Application Serial No. 09/671,966

As no new matter has been added by these amendments, the Applicant respectfully requests the entry thereof.

The Applicant respectfully requests reconsideration of the application in view of the remarks made herein.

8

Rejections under 35 U.S.C. § 112, second paragraph

Claims 41 and 42 have been rejected under 35 U.S.C. §112, 2nd ¶, on the grounds that
the terms "the front side" and "the identification code" are without antecedent basis. The
above-described amendments to Claim 41 provide antecedent basis for these terms.
Accordingly, in view of the amendment to claim 41, the Applicant respectfully requests that
this rejection be withdrawn.

Rejections under 35 U.S.C. § 102(e)

Claims 1-8 and 41-42 have been rejected under 35 U.S.C. § 102(e) as being
anticipated by U.S. Patent No. 6,2512,601 to Bao et al. This rejection is respectfully
traversed.

Independent Claims 1 and 2, and the claims that depend therefrom, have been
amended to further indicate a step that includes mounting a slide having an array that has
been previously exposed to a sample. Accordingly, the claims make clear that the array is not
exposed to the sample while the slide is in the slide holder, but rather is exposed to a sample
at a time prior to mounting of the slide in the holder.

The Examiner has indicated that while the preamble of the claims specifies a method
of reading an array that has been previously exposed to a sample, the body of the claim lacks
recitation of a step of exposing the array to a sample. As such, the Examiner asserts that Bao
et al. describe the steps of mounting a slide on a slide holder and inserting the holder into a
reader and reading the array. The bodies of Claims 1 and 2, as well as the preambles, now
clearly indicate a step of mounting a slide that includes a previously exposed array, which
step is not taught by Boa et al.

As noted in Applicants' previous communication dated December 12, 2003,
responsive to the Office Action dated September 29, 2003, Bao et al. disclose a system in
which an array with the desired target elements is manufactured and then is glued into the
cavity of the array holder (see Column 14, lines 63-67). Once in the array holder, the array is
then exposed to a sample by the user (see Column 15, lines 1-23). Unlike the claimed

9

invention of the present application, Bao et al. do not disclose a method of reading an array, where a previously exposed array is first placed in an array holder, and *then* placed in an array reader, as Bao et al. clearly describe an array glued into a cavity of an array holder during manufacture, which array is then *subsequently* exposed to a sample by a user. Therefore, Bao et al. do not anticipate claims 1 and 2, and the claims that depend therefrom.

In regards to Claims 41 and 42, the Applicant respectfully submits that Bao et al., do not anticipate these claims. As described above, Claim 41, and Claim 42 by virtue of its dependency from Claim 41, have been amended to specify that the identification code is on a front side of the slide and the array is on a rear side of the slide and that the array and identification code are read through the front side of the slide while the slide is positioned in an array reader. The claims thus specify that, and are clearly distinguished from Boa et al. in that, the array (on the rear side of the slide) and the identification code o(on the front side of the slide) of the subject claims are both read when the slide carrying the array and identification code is positioned in an array reader through the front side of the slide.

A method as claimed by the subject claims is not taught by Bao et al., as Bao et al. merely describe the use of an automated tracking system for controlling the process of manufacturing the bioarrays. As such, there is no reason why the automated tracking information of Bao et al. would be read when the Bao et al. array is positioned in an array reader as the information of Bao et al. relates to the making of the array and not to how the array is read. Accordingly, Bao et al. do not describe a method of positioning a slide in an array reader and then reading an array through the front side of the positioned slide and the identification code from the front side of the positioned slide, as required in claim 41 of the present application. Therefore, Bao et al. do not anticipate claims 41 and 42 of the present application.

For at least the reasons described above, Bao et al. fail to teach each and every element of the claimed invention. Accordingly, withdrawal of this rejection of claims 1-8 and 41-42 is respectfully requested.

10

CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10003413-1.

Respectfully submitted,
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11